

Atty. Dkt. No. 025098-0701

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the reasons that follow.

Claims 1, 3-5, and 42-50 are pending in the application. No claim has been amended. A listing of the claims is provided beginning on page 2 of this paper for the Examiner's convenience.

Claims 1, 3-5, 42-45, and 50 are allowed.

Obviousness-type Double Patenting Rejection

Claims 46-49 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly obvious various of the claims to U.S. Patent No. 6,472,537 (the "537 patent"). Applicants respectfully traverse this rejection in view of the following remarks.

The legal standard of establishing a prima facie case of obviousness-type double patenting is quite clear. As stated in the MPEP,

A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985)." (MPEP 804 section II.B.1.)

However, a double patenting rejection must rely on a comparison with the *claims* in an issued or to be issued patent (MPEP 804, section III, emphasis added). Any obviousness-type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent." (804 section II.B.1.)

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Contrary to the Examiner's assertion, the inventions of the '537 patent and the instant application are distinct. The '537 patent claims polyamides which bind to the minor groove of DNA in a sequence-specific manner and can differentiate between, for example, T-A and A-T base pairs. While the claimed polyamides of the patent are highly useful in and of themselves, the instant application provides enhanced polyamides that are conjugated to an additional moiety (the "R1" group of claim 1). In one embodiment of the instant invention, the conjugated moiety is a DNA reactive moiety that can provide for sequence specific cleavage of the duplex DNA. This additional functionality is not shown or suggested by the claims of the '537 patent.

Moreover, the Examiner has not given any reasons or made any showings, based on the prior art, to remedy the above-described deficiencies of the '537 patent's claims. Indeed, Applicants respectfully submit that the Examiner has relied on prohibited hindsight provided by the instant invention to supply the missing elements, motivation, and expectation of success required to demonstrate a *prima facie* obviousness-type double patent rejection.

For at least the reasons above, Applicants respectfully submit that the Examiner has not met his burden to show that the instant claims are obvious variations of the claims of the '537 patent. Accordingly Applicants respectfully request reconsideration and withdrawal of the rejection.

CONCLUSION

In view of the above amendments and remarks, the present application is respectfully submitted to be in condition for allowance. Accordingly, reconsideration and favorable action with respect to the pending claims is respectfully requested. In the event any issues remain to be resolved in view of this communication, the Examiner is invited to contact the undersigned at the number given below so that a prompt disposition of this application can be achieved.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to

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Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-0872.

Respectfully submitted,

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FOLEY & LARDNER LLP

Customer Number: 30542

Telephone: (858) 847-6717

Facsimile: (858) 792-6773

By 

David P. Lentini

Registration No. 33,944 for

Richard J. Warburg

Registration No. 32, 327 for

Attorneys for Applicants